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PATENT & TRADEMARK OFFICE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ATTORNEY DOCKET NO. AT9-93-110

In re Application of:	§	
	§	
TIMOTHY M. SKERGAN	§	
	§	Examiner: **TRAN, V.**
Serial No. **08/353,008**	§	
	§	
Filed: **9 DECEMBER 1994**	§	Art Unit: **2609**
	§	
For: **METHOD AND SYSTEM FOR MANIPULATING A PLURALITY OF GRAPHICAL POINTERS**	§	

REPLY BRIEF

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

This Reply Brief is submitted in triplicate in support of the Appeal in the above-identified application.

CERTIFICATE OF MAILING
37 CFR 1.8(A)
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D. C. 20231.

2-19-98
Date

Signature

ARGUMENT

In paragraph 2 of the Examiner's Answer, the Examiner erroneously states that Appellant's "brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal." Such a statement is given at page 2 of the Appeal Brief under the heading "RELATED APPEALS AND INTERFERENCES."

Next, in paragraph 7 of the Examiner's Answer, the Examiner states that the "rejection of claims 1-5, 6-9, and 10-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7)." Again, the Examiner is incorrect. Under the heading "GROUPING OF THE CLAIMS" at page 5 of the Appeal Brief, it states that "Claims 1-5 and 10-14 stand or fall together as a first group, and Claims 6-9 stand or fall together as a second group." Applicant need not provide reasons in support of the separate grouping of Claims 1-5 and 10-14 and Claims 6-9 because argument in support of the grouping of claims is required under 37 CFR 1.192(c)(7) only in instances in which the appellant is arguing that multiple claims rejected based upon the same ground of rejection are separately patentable. When, as here, the Examiner has applied a different ground of rejection (i.e., a different reference) to each group of claims, Appellant need not argue that the claims are separately patentable.

The Examiner then states in paragraph 12 of the Examiner's Answer that the "examiner's answer does not contain any new ground of rejection." This, too, is wrong. In the Final Rejection dated April 24, 1997, and labelled Paper No. 6, the Examiner rejects Claims 1-5 and 10-15 under 35 U.S.C. § 102(b) as anticipated by the *MacDraw Pro User's Guide* published by Claris Corporation (hereinafter, *Claris*). Claims 6-9 are separately rejected under 35 U.S.C. § 102(b) as anticipated by *Macintosh MacPaint* published by Apple Computer (hereinafter,

Apple). Now, at page 5, paragraph 3 of the Examiner's Answer, the Examiner impermissibly attempts to apply *Claris* to Claims 6-9 to compensate for the deficiencies in the Examiner's rejection noted at page 8 of Appellant's Appeal Brief. Applicant therefore respectfully requests that the Board instruct the Examiner that 37 C.F.R. § 1.193(a) prohibits the Examiner from introducing a new ground of rejection in the Examiner's Answer.

Finally, upon review of the Examiner's Answer, Appellant also notes that the Examiner has restated the rejection of the claims in the first group to clarify that the Examiner is relying upon the scroll buttons illustrated in Figure 1-17 of *Claris* to teach the plurality of graphical pointers (see, e.g., page 3, lines 14-16 of the Examiner's Answer), the switch (see, e.g., page 3, lines 16-18 of the Examiner's Answer), and the point (see, e.g., page 4, lines 15-17 of the Examiner's Answer) recited in the present claims. A careful examination of the language of Claim 1, however, reveals that *Claris* cannot identically disclose all of features of Claim 1 as required by 35 U.S.C. § 102, given the Examiner's application of the cited reference. For example, the Examiner's application of *Claris* to the step of "manipulating said one graphical pointer . . . during said selection of said one graphical pointer" requires *Claris* to disclose concurrent selection and manipulation of a scroll arrow. A review of *Claris* reveals that the cited reference fails to even disclose the selection of a scroll arrow, much less identically disclose the concurrent selection and manipulation of a scroll arrow. *Claris* similarly fails to identically disclose the step of "selecting a point within said display device in response to closure of a switch associated with said one graphical pointer" as recited in Claim 1. Assuming *arguendo* that the "switch" recited in Claim 1 is disclosed by *Claris'* scroll arrow as asserted by the Examiner, the "closure of a switch" recited in Claim 1 would correspond to the selection of a scroll arrow. Given that the Examiner also believes that *Claris'* scroll arrow discloses the "point" recited in Claim 1, the Examiner's interpretation of the selecting step recited in Claim 1 amounts to: "selecting a scroll arrow in response to selection of a scroll arrow." As should thus be apparent, the Examiner's deformation of the teaching

of *Claris* to obtain the present invention results in a nonsensical interpretation of the language of the present claims. Appellant therefore urges the Board to reverse the Examiner's rejection of the claims.

No additional fee is believed to be required; however, in the event an additional fee is required please charge that fee to Deposit Account No. 09-0447. No extension of time is believed to be required; however, in the event an extension of time is required, please consider that extension requested and please charge any associated fee therefore to the above-identified Deposit Account No. 09-0447.

Respectfully submitted,

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